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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,002	10/10/2001	Tetsuya Hiraoka	011349	4785

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EXAMINER

CRUZ, LOURDES C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,002

Applicant(s)

HIRAOKA ET AL.

Examiner

Lourdes C. Cruz

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

All figures showing a cross-sectional view of the invention are improperly crosshatched. All of the cross hatching patterns should be selected from those shown on page 600-81 of the MPEP based on the material of the part. Also see 35 CFR 184 (h)(3) and MPEP 608.02.

Claim Objections

Claims 1 and 7 are objected to because of the following informalities: The claims recite "at an inward position of said first... adjacent from the third..." It is the understanding of the examiner, from what can be gathered from the specification and the claims that the above should be: *at an inward position from said first... adjacent to the third...* in order to make the sentence clearer, more definite, and more grammatically proper. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "the side surface of the second end" and "a side surface of the seal member". See that this claim has raised a great deal of uncertainty due to the fact

that although claim 1 recites "a side surface thereof", this statement does not provide antecedent basis for both a side surface of the seal member, and a side surface of the second end. Evidently, **claim 1** needs to be amended to more clearly specify what "thereof refers to", since its scope has been rendered unclear.

Claims **2** and **5** have not been rejected over the prior art because, in light of the 35 U.S.C. 112 rejections supra, there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. See also MPEP 2173.06.

Regarding the 35 U.S.C. 112 rejections supra above, it is unclear what the role of the bonding wires (**claim 2**) in the structure is, based on the claim as drafted. Although the specification provides a dictionary for the claims, each claim must be complete and self consistent in itself. Additionally, the elements of the claims must be bound together structurally and functionally so that the claim describes a functionally operating system. **Claim 5** has failed to logically state the sequential operation of the elements working cooperatively. For example, it is unclear to which pads is the fourth plurality of pads connected to. It would appear from the drawings that the second chip has two sets of pads, but that has not been recited in the claim so that the scope of the claim is set clear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 4, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al. (US 6359340).

Lin et al. discloses a semiconductor device (see Fig. 10) comprising:

A substrate 560 having a first plurality of pads (connected to 512) and a second plurality of pads (connected to 542); a first semiconductor chip 510 mounted on said substrate and having a third plurality of pads 510a; a plate member 520 arranged on said first semiconductor chip having a first end (end under 540) at an inward position from/"of" said first semiconductor chip adjacent to/"from" the third plurality of pads, and a second end being exposed to an outside (in as much as "an outside" defines any specific part of the seal member) of a seal member (see col. 7, lines 40+ wherein "a package" is described inherently describing packaging/encapsulation/sealing of the device) through a side surface thereof; a second semiconductor chip 540 arranged on said plate member having a forth plurality of pads 540a; a first structure 512 and a second structure 542 respectively and electrically interconnecting said third plurality of

pads of said first chip with said first plurality of substrate pads and said fourth chip pads with said second substrate pads and the seal member sealing said first semiconductor chip and said second chip (see above for explanation about sealer inherency)

Regarding the limitation "... end being flush with said first semiconductor chip", see that the prior art teaches a plate member with more than one "end", two of which (surfaces in contact with chips) are flush with the chips.

Lin et al. also discloses:

- See that the plate member has portions protruding from the first and second chips, and portions covered by the first and second chips
- See that the plate member of the prior art comprises plural layers

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lourdes C. Cruz whose telephone number is 703-306-5691. The examiner can normally be reached on M-F 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Lourdes C. Cruz
Examiner
Art Unit 2827


Lourdes Cruz
January 18, 2003


KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
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